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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,688	03/23/2001	George Harry Hoffman	41556/04031 (RS11P043)	5849
22428	7590	06/16/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			GORT, ELAINE L	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,688

Applicant(s)

HOFFMAN ET AL.

Examiner

Elaine Gort

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-7,9,11-13,15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,9,11-13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17,18.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. Claims 1, 3, 5-7, 9, 11-13, 15, 17 and 18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all the claims filed in the following Applications because they are not patentably distinct:

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09/816944

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 9, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the method of claim 2" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 2 has been cancelled.

Claim 9 recites the limitation "the system of claim 8" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 8 has been cancelled.

Claim 15 recites the limitation "the computer program product of claim 14" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 14 has been cancelled.

It is unclear in claims 3, 9 and 15 if the data is made accessible to the convenience store outlets, the convenience store distributor, "***and/or***" the convenience store supplier via a network-based interface. It appears the applicant has inadvertently omitted either the term "and" or "or" prior to the terms "the convenience store supplier".

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 7, 9, 11-13, 15, 17 and 18 are rejected because they lack patentable utility. Claims 7, 9, 11-13, 15, 17 and 18 only claim the manipulation of data ("logic for" and "computer code for") but perform no concrete, useful or tangible result. For example, this rejection may be overcome by positively claiming the generation of a report or output of data.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3, 5-7, 9, 11-13, 15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shavit et al. (US Patent 4,799,156) in view of Microsoft Press Computer Dictionary.

Shavit et al. discloses a computer program product with code, a system with logic and a method for managing a convenience store supply chain utilizing a network, comprising:

A supply chain system computer receiving data from a plurality of independent convenience store outlets of a convenience store supply chain utilizing a network (for example see figure 2 showing the supply chain system computer network system; see column 5 lines 50+ regarding network; column 12 line 42 to column 14 line 10 discuss the receiving of data from independent "outlets" such as a buyer over the network), the

data relating to the sale of convenience store products or services by the convenience store outlets, (data entered by buyers is data relating to the sale of goods, see column 6 lines 19+ and see column 12 lines 54+ regarding the types of information entered by buyers into the system such as the terms including description, part number, price, type of agreement, etc. which are entered by a buyer to get a quote, see column 13), and where the data is provided by the plurality of convenience store outlets at the sole discretion of the respective convenience store outlet (for example see figure 2 illustrating more than one buyer (82); buyers provide the data at there sole discretion when requesting quotes);

The supply chain system computer sending the data to match it to a plurality of convenience store distributors and convenience store suppliers (the systems takes buyer's data and sends it to distributors and suppliers for quotes);

The supply chain system computer generating an electronic order form based on the data for ordering convenience store products or services from a convenience store distributor of the convenience store supply chain (column 13 lines 50+ disclose the generation of electronic order forms such as when an outstanding bid which is based on the data is converted to an order);

The supply chain system computer transmitting the data to the convenience store distributor of the convenience store supply chain utilizing the network (such as when the request for quote is transmitted to the distributor and the distributor receives the data in order to generate a quote, for example see column 13 lines 17+ and column 6 line 19+);

The supply chain system computer transmitting the data to a convenience store supplier of the convenience store supply chain utilizing the network (such as when interactive concurrent sessions with multiple parties for closing details of a shipment has to be coordinated with an agent or distributor and supplier, for example see column 6 lines 52+, column 11 lines 11+, and column 15 lines 2+);

The supply chain system computer forecasting aggregated activity in the convenience store supply chain utilizing the data (users are provided forecasting computing services, see column 7 lines 15+);

Sending the electronic order form to the convenience store distributor (such as when the order is sent to the distributor after the seller converts it to an order; column 6 lines 30+ discusses how distributors are provided access to orders);

The supply chain system computer providing access to the forecast to the convenience store distributor and the convenience store supplier only after identity verification (users are provided access to forecasting, column 7 line 15+; column 9 lines 42+ to column 10 line 44 discuss identity verification and security for limiting access to information);

(Regarding claims 3, 9 and 15) where the data is made accessible to the convenience store outlets, the convenience store distributor, the convenience store supplier via a network-based interface (see figure 2 showing network access to system); and

(Regarding claims 6, 12, and 18) where the convenience store outlets, the convenience store distributor and the convenience store supplier each forecast utilizing

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the data (users are provided forecasting computing services within the supply system, see column 7 lines 15+).

Shavit et al. discloses the claimed method, system and computer program product but is silent regarding how the data is handled within the system and processed among the parties and thus is silent regarding parsing of the data. Microsoft Press Computer Dictionary, discloses that it is known in the art to parse data to break input into smaller chunks so that a program can act upon the information (see definition of "parse" on page 355). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method, system and computer program product of Shavit et al. with the parsing of data as taught by Microsoft Press Computer Dictionary, in order to break the data relating to sales into smaller chunks so that the system can act upon the information in sending it to distributors, suppliers, brokers, etc...

(Regarding claims 5, 11 and 17) Shavit et al. and Microsoft Press Computer Dictionary, as modified above, discloses the claimed method, system and computer program product but is silent regarding the use of the Internet. Microsoft Press Computer Dictionary discloses that it is known in the art to use the Internet for high-speed reliable communications (see definition of "Internet" on page 258). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the method, system and computer program product of Shavit et al. and Microsoft Press Computer Dictionary, as modified above, with Internet access as taught

by Microsoft Press Computer Dictionary, in order to provide users with high-speed reliable communications.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 3, 5-7, 9, 11-13, 15, 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391.

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The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Elaine Gort
Examiner
3627

June 10, 2004



ROBERT P. OLSZEWSKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600